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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/579,099	03/22/2007	Reiner Fischer	2400.0400000/JMC/THN	6737

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STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.  
1100 NEW YORK AVENUE, N.W.  
WASHINGTON, DC 20005

EXAMINER
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RODRIGUEZ-GARCIA, VALERIE

ART UNIT	PAPER NUMBER
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1626

MAIL DATE	DELIVERY MODE
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11/10/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/579,099	<b>Applicant(s)</b> FISCHER ET AL.	
	<b>Examiner</b> VALERIE RODRIGUEZ-GARCIA	<b>Art Unit</b> 1626	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 August 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6,8,9,11-15 and 17-19 is/are pending in the application.
- 4a) Of the above claim(s) 6, 9, 11-15 and 17-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-5 and 8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **Status of the Claims**

**Office Action.**

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## Rejections and Objections

1. The objections of claims 1-5 and 8 are withdrawn in view of applicant's amendments.
2. The Affidavits under 37 CFR 1.132 filed on August 13,, 2009 disclosing "unexpected superiority of Applicant's elected compound" is not sufficient to overcome the rejections of claims 1-5 and 8 under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,045,560 and US Patent 5,258,527 because:
  - The reported data does not include error bars or any kind of statistical analysis as required by scientific method.

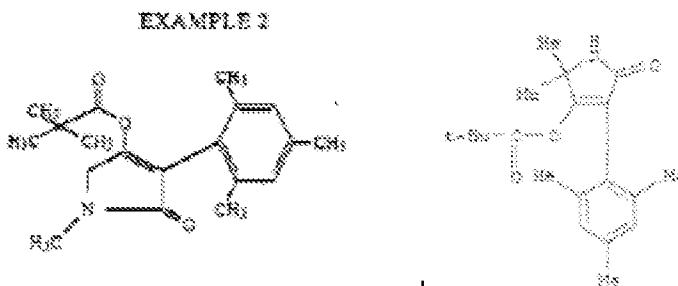
- The plant population treated before and after emergence is not known.

Therefore, a conclusion can not be made in regards to the meaning of the killing percentages presented in the Affidavit. For example, if only two plants were treated and one died, this would give 50% efficacy. For statistically significant results experiments require a representative sample of the population.

### **Applicant's arguments**

Applicants argue that the cited references and the Examiner do not provide a reason to modify the compounds disclosed in the references to arrive at the genus of the present invention and that the references disclose many compounds that are described to be suitable and not many have been tested. Applicants additionally argue that the Office used impermissible hindsight in selecting the compounds the Examiner selected from the prior art to arrive at the presently claimed compounds.

Applicant's arguments have been considered but are not found persuasive. The



Examiner identified the compounds and of the prior art. The prior art shows the compounds were made and teaches their use as pesticide and herbicide. This is why a person of ordinary skill in the art would have selected the compounds above. There is no need for Applicants or authors to test all compounds made and claimed in order to show efficacy. Regardless of the compounds

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been tested, the disclosure of these compounds in the prior art and the teaching and testing of other similar species enables the disclosed use of the compounds. To a person of ordinary skill in the art the compounds disclosed in the prior art are considered effective, unless the prior art discloses the opposite.

The Examiner also provided reasons to modify the compounds disclosed in the references to arrive at examined compounds. The Examiner showed that the prior art compound and the instant compound are only different by a methyl, therefore are homologues. The Examiner provided further motivation in the previous action:

To those skilled in the art, one homologue is not such an advance over adjacent member of series as requires invention because chemists knowing properties of one member of series would in general know what to expect in adjacent members. *In re Henze*, 85 USPQ 261 (1950). The instant claimed compounds would have been obvious, because one skilled in the art would have been motivated to prepare homologues of the compounds taught in the reference with the expectation of obtaining compounds which could be used in herbicidal and insecticidal compositions.

The MPEP § 2144.09 states “Compounds which are homologs, differing regularly by the successive addition of the same chemical group, e.g., by  $-CH_2-$  groups, are generally of sufficiently close structural similarity that there is a presumed expectation that such compounds possess similar properties. {*In re Wilder*, 563 F.2d 457, 195 USPQ 426 (CCPA 1977)}.

Similarly, the courts have recognized that *even in the case of homologs, a rejection on the basis of structural relation may be improper, with the critical question to be answered being whether the moieties of the molecules under consideration are*

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*considered 'homologous' under some available definition or whether they 'are sufficiently similar from the standpoint of structural similarity, so that those now claimed would be suggested to chemists from those disclosed and would be expected to have like properties. (See Ex parte Burtner and Brown, 121 USPA 345 (1951)).*

Moreover, the courts have recognized that *when expectation of similar properties stands un rebutted, it necessarily follows that expectation of similar uses also stands un rebutted, [with] expectation of similar use necessarily implying expectation of substantially equivalent substitute(s). Furthermore, there is no logical basis for distinguishing patentably between a prior art [homologous] compound and a claimed novel compound prima facie obvious therefrom, even where a previously unknown or unobvious use has been found, where that use nevertheless inheres in both compounds and it is the compound per se that is claimed. {See In re Hoch, 57 CCPA 1292, 428 F.2d 1341, 166 USPQ 406 (1970)}.*

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Therefore, the rejections of claims 1-5 and 8 under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,045,560 and US Patent 5,258,527 **are maintained**.

3. Claims 1-5 and 8 **remain rejected** on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 5,045,560, claims 1-5, 7 and 10 of U.S. Patent No. 5,258,527.

Applicants submit the same arguments as above. Applicants arguments are unpersuasive.

The Examiner reiterates the reasoning stated above. Additionally, the compounds of the instant invention have been originally claimed and protected by the recited patents. The genus recited in the patented claims is of sufficiently limited scope so as to enable a person of ordinary skill in the chemical arts at once envision the examined/elected species within the generic chemical formula.

4. Claims 1-5 and 8 **remain** provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 and 12 of copending Application No. 11/666870.

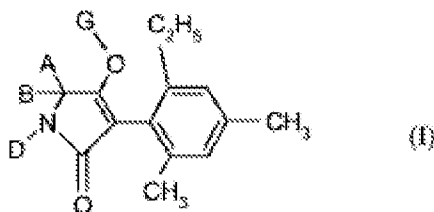
Applicants request to hold this rejection in abeyance.

#### Note to Applicants

If the Affidavit would be enough to overcome the obviousness 103(a) rejections on the two examined compounds, only the following scope of the claimed invention could be considered to relate to it:

#### ***The scope of the invention***

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Compounds of formula I,

depicted in claim 1,

wherein:

A represents hydrogen, in each case optionally halogen-substituted alkyl, alkenyl, alkoxyalkyl or alkylthioalkyl or optionally substituted cycloalkyl,

B represents hydrogen, alkyl or alkoxyalkyl,

D represents hydrogen or an optionally substituted radical selected from the group consisting of alkyl, alkenyl, alkynyl, alkoxyalkyl, alkylthioalkyl, and cycloalkyl,

### Conclusion

Claims 1-5 and 8 remain rejected. No claims are allowed.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.



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Any inquiry concerning this communication or earlier communications from the examiner should be directed to VALERIE RODRIGUEZ-GARCIA whose telephone number is (571)270-5865. The examiner can normally be reached on Monday-Friday, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kamal A Saeed/  
Primary Examiner, Art Unit 1626

VRG  
Art Unit 1626